

Appl No.: 10/668,726

Atty. Dkt.
PC1511**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 6, canceled claims 5, 7-9, 17-24 and added new claims 25-34. Replacement drawing Fig. 6 is included to show a "tanning bed" 190. No new matter has been entered, since this feature was described on page 8 of the originally filed specification. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks. Applicant gratefully appreciates the examiners indication that claims 10-16 are allowable.

Claim 1 has been amended to include the limitations of former dependent claims 5, 7 and 8. Claim 1 has been amended to clarify the novel system includes a "plastic" "mouthpiece", the "face end" and "rear end" of the "mouthpiece" have "outside opening(s)" therethrough, and also that the light source is a "single tanning lamp having an artificial UV(ultraviolet) light source that emits light within the range of approximately 200 nm to approximately 400 nm, the single lamp adaptable for beaming light on both" exposed skin of the user and onto the exposed frontal teeth of the user so that the exposed frontal teeth and the exposed skin of the user receive the light beam from the same single tanning lamp.

Claim 6 has been amended to clarify that the system can include a "kit" that consists of the "plastic mouthpiece" and the "whitening agent."

New independent claim 26 recites the novel "kit system" that comprises "a mouthpiece solely formed from plastic and consisting of an oblong and oval shaped plastic frame having a face end with an outside opening therethrough and a rear end having an outside opening therethrough....a whitening agentand a package for housing the plastic mouthpiece and the whitening agent.....wherein a single artificial UV(ultraviolet light source) is adaptable to both tan exposed skin of the user and whiten the upper and the lower frontal teeth of the user.

New dependent claims 25 and 34 recite the novel combination of a "tanning bed" being used with the novel "tanning and whitening system" of claim 1 and the novel "kit system" of new independent claim 26.

New dependent claims 27-33 claim further novel features of the novel shape configuration of the plastic mouthpiece and the single UV artificial light source that is used to both tan exposed skin and whiten frontal teeth of the user.

Claims 17-20, 23 and 24 were rejected under the judicially created doctrine of obviousness type double patenting as being rejected over the claims of U.S. Patents D508,563

Appl No.: 10/668,726

Atty. Dkt.
PC1511

and D508,996 to the same inventor and assignee as that of the subject invention. Applicant has filed a terminal disclaimer with the subject amendment response. Thus, removal of this rejection is respectfully requested.

Claim 9 was rejected under sec. 101, and claim 9 was further rejected under sec. 112, second paragraph. These rejections are now moot since claim 9 has been canceled.

Claims 1-4, 17-20, 22 and 24 were rejected over sec. 102b as being anticipated by Gilbert '664. As admitted by the Examiner on page 5 of the office action mailed February 24, 2006, Gilbert describes a "metal" mouthpiece, while the subject invention independent claims 1 and 26 require a "plastic" mouthpiece. Additionally, independent claim 1 has been amended to include the novel features of former dependent claims 7 and 8, and that a "single tanning lamp" that is adaptable to both tan exposed skin and white front teeth of the user. These features are clearly not described, taught or suggested by Gilbert. Thus, removal of this reference is respectfully requested.

Claims 1, 3, 5 and 6 were rejected over sec. 102c as being anticipated by Jensen '283. Jensen clearly shows and describes a handheld type hand tool having a "light guide" Figures 1-5 with a "handle" that clearly encompasses a light source that must be solely directed to an arch covering the teeth of a patient. No such handheld light guide is claimed by the subject invention.

Subject independent claim 1 has been amended to clarify the novel system includes a "plastic" "mouthpiece", the "face end" and "rear end" of the "mouthpiece" have outside opening(s) therethrough, and also that the light source is a "single tanning lamp having an artificial UV(ultraviolet) light source that emits light within the range of approximately 200 nm to approximately 400 nm, the single lamp adaptable for beaming light on both exposed skin of the user and onto the exposed frontal teeth of the user so that the exposed frontal teeth and the exposed skin of the user receive the light beam from the same single tanning lamp.

Clearly, the outside openings to the face end of the claimed invention mouthpiece are substantially structurally different than the closed light guide hand tool.

Still furthermore, the subject invention limits their mouthpiece to be "plastic", which is clearly different than the hand tool type device of Jensen that requires light sources that can include "heat lamps", "conventional dental light guides" and "laser devices", as described in column 19, lines 38-42.

Still furthermore, Jensen clearly only wants to direct the radiant energy to "teeth" and does not use the same light source for tanning which is done by the subject claimed invention. In fact, Jensen clearly implies that their light source would be harmful to exposed skin by including

Appl No.: 10/668,726

Atty. Dkt.
PC1511

"conventional dental light guides" and "laser devices, and the like" as the light sources. Thus, removal of the Jensen reference is respectfully requested.

Claims 1-4, 17-20 and 23 were rejected over sec. 102b as being anticipated by Good '660. As admitted by the Examiner on page 6 of the office action mailed February 24, 2006, Good does not describe the material of their mouthpiece, while the subject invention independent claims 1 and 26 require a "single plastic" mouthpiece. Additionally, independent claim 1 has been amended to include the novel features of former dependent claims 7 and 8, and that a "single tanning lamp" that is adaptable to both tan exposed skin and white front teeth of the user. These features are clearly not described, taught or suggested by Good. Thus, removal of this reference is respectfully requested.

Claims 5, 7-9 and 21 were rejected under sec. 103 as being unpatentable over Gilbert '664. Applicant strongly disagrees and believes this rejection is in error to state that it would be well known to substitute a "plastic" mouthpiece as claimed in the subject invention for the "metal" mouthpiece described by Gilbert. Applicant further strongly disagrees and believes this rejection is in error to state that one would use the novel UV ranges from an artificial light source as claimed in the subject claims. Gilbert clearly does not describe a "single tanning lamp" that is adaptable to both tan exposed skin and white front teeth of the user. These features are clearly not described, taught or suggested by Gilbert. Thus, removal of this reference is respectfully requested.

Claims 5, 7-9 and 21 were rejected under sec. 103 as being unpatentable over Good '660. Applicant strongly disagrees and believes this rejection is in error to state that it would be well known to substitute a "plastic" mouthpiece as claimed in the subject invention for the Good mouthpiece. Applicant further strongly disagrees and believes this rejection is in error to state that one would use the novel UV ranges from an artificial light source as claimed in the subject claims. Good clearly does not describe a "single tanning lamp" that is adaptable to both tan exposed skin and white front teeth of the user. These features are clearly not described, taught or suggested by Good. Thus, removal of this reference is respectfully requested.

As to the sec. 103 rejections of record, the mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Appl No.: 10/668,726

Atty. Dkt.
PC1511

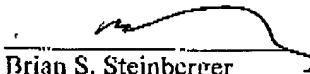
There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The remaining dependent claims of record are also not described, taught or suggested by the references of record. For example, the "tanning bed" of claims 25 and 34, which was described on at least page 8, lines 20-22 of the specification is clearly not described, taught or suggested by the references of record.

Applicant contends the references cannot be modified to incorporate the features of subject claims 1-4, 6, 25-34 in addition to allowed claims 10-16 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1-4, 6, 25-34 be allowed in addition to previously allowed claims 10-16. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;



Brian S. Steinberger
Registration No. 36,423
101 Brevard Avenue
Cocoa, Florida 32922
Telephone: (321) 633-5080

Date 5/24/06